

08 MAY 2008



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In re Application of
GREENBERG (Deceased)
Application No.: 10/599,723
PCT No.: PCT/US05/11476
Int. Filing Date: 05 April 2005
Priority Date: 06 April 2004
Attorney Docket no.: 20151/1201061-US1
For: PARKING FACILITY

DECISION ON
REQUEST
UNDER 37 CFR 1.42

This is a decision on applicant's declaration filed in the United States Patent and Trademark Office (USPTO) on 21 December 2007 treated as a request under 37 CFR 1.42. Petitioner requests a five month extension of time, which is granted.

BACKGROUND

On 06 October 2006, within the thirty month period, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee.

On 21 May 2007, a Notification of Missing Requirements was mailed to applicant, indicating that the oath or declaration, in compliance with 37 CFR 1.497(a) and (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 21 December 2007, applicant filed a declaration of the inventor, identifying the deceased sole inventor Mersh Greenberg and Bonnie Greenberg, as the legal heir/representative of deceased inventor along with the surcharge for filing the declaration after the thirty month period.

DISCUSSION

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent.

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative.

The declaration does not identify the citizenship of Bonnie Greenberg, who indicates that she is the legal heir/representative of the deceased inventor. Citizenship is required under 37 CFR 1.497(b)(2). In addition, the declaration does not clearly state whether Bonnie Greenberg is the legal representative or whether she is an heir. If she is an heir, is she the sole heir? That is, there may be other heirs who are also required to sign the declaration. Since the declaration fails to identify the citizenship of the heir/legal representative and it is unclear whether Ms. Greenberg is the legal representative or the sole heir or if there are other heirs, the declaration is defective under 37 CFR 1.497(b).

The new declaration must state the relationship to the deceased inventor and state the country of citizenship, former residency and mailing address for *both* the deceased inventor and the legal representative, to meet the requirements for compliance with 37 CFR 1.497(a) and (b). Any person acting as a legal representative of a deceased inventor should ensure that he is properly acting in such capacity. If Ms. Greenberg is the sole heir, the declaration should so state. If there are other heirs, the declaration must identify these heirs, indicate their respective citizenship, residency and mailing address and be executed by these heirs. It is also noted that text is missing from the bottom of Page 2 of the declaration.

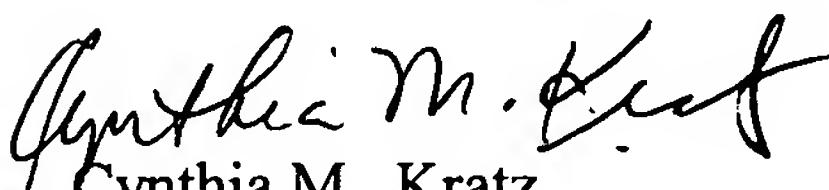
For the reasons stated above, a new declaration is required in compliance with 37 CFR 1.497 and 1.64. Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE**.

Applicant is required to correct the above-noted defects including the furnishing of a oath/declaration in compliance with 37 CFR 1.42 and 1.497 within TWO (2) MONTHS from the mail date of this Decision.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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